

**REMARKS**

***Status of Application***

Claims 1-3, 5-10, 14-23 and 25-29 constitute all currently pending claims in the above-mentioned application.

***Claim Rejections Under 35 U.S.C. § 102***

Claims 1, 2, 5 and 25 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,391,439 to Nakano ("Nakano"). Applicant traverses this rejection for at least the following reasons.

Claim 1 requires that "indication information is written by irradiating light in a form of an image onto the indication layer." The Examiner contends that this feature is disclosed by Nakano, in particular by the descriptions in column 5, lines 48-55 of Nakano regarding "a photoelectro-magnetic disc."

Nakano appears to disclose, as a rewritable indication layer which is separated from a recording medium 8, a magnetic recording layer which includes microcapsules 10 containing liquid 12 and flake magnetic fine particles 11, and a heat-sensitive recording layer 2 which can be reversibly changed by heat from a transparent state to an opaque state. However, the photoelectro-magnetic disc, which the Examiner emphasizes in the Office Action, is not used for a rewritable indication layer, but rather, for the recording medium 8. (See Nakano at Fig. 1; col. 5, lines 49-56 and paragraph 51). The rewritable material is attached to the recording medium 8. The Examiner impermissibly interchanges the characteristics of completely different disclosed layers in making the rejection.

Furthermore, indication images at the rewritable indication layer of Nakano are provided (written) by respectively switching (changing) applications of magnetic fields, e.g., a vertical

magnetic field  $\Phi V$  in Fig. 2, and a horizontal magnetic field  $\Phi P$  in Fig. 3. (Nakano at col. 4, lines 20-35.) In contrast, indication images (the indication information) at the indication layer of claim 1 are provided (written) by switching (changing) application of irradiating light.

Therefore, Nakano lacks any teaching of a method of writing indication information by irradiating the surface of the label base layer with light, and further, the rewritable indication layer of Nakano relates to magnetization, not to light irradiation.

Thus, Nakano fails to identically disclose each and every required element of independent claim 1 and, therefore, fails to anticipate claim 1. Accordingly, Applicant respectfully requests that the rejection of independent claim 1 and its dependent claims 2, 5, and 25.

***Claim Rejections Under 35 U.S.C. § 103***

**Anderson '205 in view of Araki**

Claims 3, 22, 23 and 26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,778,205 to Anderson et al. ("Anderson '205") in view of U.S. Patent App. Pub. No. 2003/0103762 to Araki et al. ("Araki"). Applicant traverses this rejection for at least the following reasons.

Claim 3 requires that the "recording medium is substantially planar and circular in shape." The Examiner continues to assert that "substituting an indication layer of a cholesteric layer and a transparent electrode on a light absorbing layer in place of the writable label of Anderson . . . is well within the scope of knowledge that is known to one of ordinary skill in the art because the substitution results in a predictable result." (Office Action at 3, citing prior Office Action of July 18, 2008 at 3.)

In the Amendment filed on October 20, 2008, Applicant argued that the Examiner's motivation to combine Anderson '205 with Araki was unsupported, citing specific reasons why the combination was inappropriate. In the instant Office Action, the Examiner fails to directly address these reasons, instead merely citing language from the MPEP.

Applicant respectfully submits that regardless of the Examiner's understanding of the § 103 and the MPEP, the Examiner must apply that understanding to rebut the specific arguments of the Applicant. "Where the Applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the Applicant's argument and answer the substance of it." MPEP § 707.07(f) (emphasis added). Applicant, therefore, respectfully requests that the Examiner directly address the above-described deficiency in the combination of references asserted.

Fig. 1 of Araki shows a device in which a plurality of rectangular image record media 14 having connectors 12 and external connection electrodes 13 are slotted into a medium connection section 11. Neither Araki nor Anderson '205 teach or suggest how to integrate the indication layer of Araki with an optical disk such as that of Anderson '205.

Although the Examiner asserts that this is merely a simple substitution, a simple substitution would render the device inoperable. This is because external connection electrodes are required for the indication layer of Araki, while no such electrodes exist in Anderson '205. Thus, if the indication layer of Araki is to be used with a disc, as in Anderson '205, the Examiner must explain how one of skill in the art would be led to modify these references to arrive at the claimed invention.

Specifically, Araki and Anderson '205 fail to teach or suggest how to modify elements 12 and 13 of Fig. 1 of Araki to overcome the fact that the circular shape and rotating motion of an

optical disk would prevent it from being slotted into a device such as the medium connection section 11 of Araki.

Thus, Anderson '205 and Araki, alone or in combination, fail to teach or suggest each and every required element of claim 3. These references, therefore, fail to render claim 3 unpatentable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 3 and its dependent claims 22, 23, and 26.

Anderson '205 in view of Anderson '586

Claims 6, 7, 9, 10, 14-19, 21 and 27-29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of U.S. Patent No. 7,145,586 to Anderson et al. ("Anderson '586"). Applicant traverses this rejection for at least the following reasons.

Claim 6 recites "a detection section detecting a difference between storage data which is stored at the storage layer of the recording medium, and new data which is to be subsequently stored; and a generating section which . . . generates indication information which corresponds to the difference . . . and the writing section writes, at the indication layer, the indication information which corresponds to the difference." The Examiner states that these features are disclosed by Anderson '586, in particular by the descriptions in col. 6, line 9 to col. 8, line 3.

Anderson '586 appears to disclose determining new information related to the data side of an optical disc (S608), determining existing marking on the data side or the label side of the optical disc (S610), and updating marking based on the information related to the new data side of the optical disc (S612). (See Anderson '586 at col. 7, lines 49-63.)

However, Anderson '586 does not disclose or suggest the above-quoted features, namely successive processes to detect a difference between storage data stored at the storage layer of the

recording medium and new data which is to be subsequently stored, to generate indication information corresponding to the difference, and to write only the indication information which corresponds to the difference. Accordingly, Anderson '586 does not teach or suggest how to update marking based on the information related to the new data side of an optical disc.

Furthermore, if the Examiner is attempting to argue that the step of "detecting a difference" is inherent to updating the marking, the Examiner must provide evidentiary support or reasoning that shows such a step is strictly necessary in order to update the marking in Anderson '586.

When "relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art." MPEP § 2112[IV] (emphasis modified) (citations omitted). The Examiner has not, as of yet, provided evidence or reasoning sufficient to support an argument of inherency with respect to "detecting a difference" as required by claim 6.

Thus, Anderson '205 and Anderson '586, alone or in combination, fail to teach or suggest each and every required element of claim 6. These references, therefore, fail to render claim 6 unpatentable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 6 and its dependent claims 7, 9, 10, 14, 15, 27, and 29.

Independent claim 16 recites features similar to those of claim 6. Claim 16 is, therefore, also patentable at least for reasons analogous to those presented above with respect to claim 6. Accordingly, Applicant respectfully requests that the Examiner also withdraw the rejection of independent claim 16 and its dependent claims 17-19, 21, and 28.

Anderson '205 in view of Anderson '586 and Nakano

Claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 and Anderson '586, and in further view of Nakano. Applicant traverses this rejection for at least the following reasons.

Claims 8 and 20 depend from independent claims 6 and 16, respectively. The deficiencies of Anderson '205 and Anderson '586 with respect to these claims are demonstrated above. Nakano, moreover, fails to remedy these deficiencies. Claims 8 and 20 are, therefore, also patentable at least by virtue of their dependence from claims 6 and 16. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of dependent claims 8 and 20.

***Conclusion***

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

This Amendment is being filed via the USPTO Electronic Filing System (EFS).

Applicant herewith petitions the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time if necessary. Any fee due under 37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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